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UNITED STATES PATENT AND TRADEMARK OFFICE

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10/759,966	01/16/2004	Jordi Albornoz	POU920030137US1	8190

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/759,966	ALBORNOZ, JORDI
	Examiner	Art Unit	
	Clifford Madamba	3609	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on <u>25 July 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Status of Claims

This action is in reply to the remarks and amendment filed on July 25, 2007.

Claims **1-2** and **4-20** have been amended.

Claims **1-20** are currently pending and have been examined.

Previous Claim Rejections - 35 USC § 101

Claims 10-16 were rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter. The Applicant has amended the claims. The rejections are withdrawn.

Response to Arguments

The Applicant's arguments filed on July 25, 2007 have been considered but are not persuasive. The Applicant's arguments will be addressed in sequential order as they were set forth in the "Remarks" section.

With regard to claims **1, 10** and **17** as well as claims **2-9, 11-16** and **18-20** which depend on the independent claims, the Applicant asserts that the cited reference does not teach the claimed features of the claimed invention or that it teaches features that are different as follows:

- *That a user is not notified in response to determining that an automatic recurring payment is to be executed.* With regard to this assertion, this feature is taught by Ensel in at least column 10, lines 36-39 wherein "examples of the type of information included in the enrollment database includes, but is not limited to: ...reminder preferences (e.g., as soon as possible, at the end of the month, 5 days before due date, 5 days late, no reminder...) as well as reminder channels (e.g., email, paper mail, fax, phone call, beeper...)" and in at least column 14, lines 38-41 wherein "the enrollment database can also track unopened bills and generation reminders as specified in the reminder preferences contained in the enrollment database file."

- *That Ensel is directed towards notifying a user of a bill, not of an automatic recurring payment that is to be executed.* With regard to this assertion, this feature is taught by Ensel in at least column 10, lines 43-45 wherein "examples of the type of information included in the enrollment database includes, but is not limited to: ...payment preferences (e.g., preauthorized, on due date, at end of month, full or fixed amount, automatic within limit)..." This feature is also taught by Ensel in at least column 4, lines 48-51 which indicates that "using preauthorization, the user may authorize the information interface provider to debit a preselected consumer account with respect to certain bills, typically recurring bills for the same amount, e.g., a mortgage payment."

- *That sending email containing a bill is very different from sending a notification to notify the user that an automatic recurring payment is to be executed.* With regard to this assertion, Ensel teaches a notification means not only for bill availability [see at least column 10, lines 36-39] but for recurring payments as well [see at least column 4, lines 48-51].

- *That Ensel only discloses executing payments without prior user intervention.* With regard to this assertion, Ensel teaches in at least column 7, lines 12-13 wherein customer responses may be provided for "via link", further wherein in at least column 7, lines 60-64, "customer responses are transmitted to the biller". Ensel also teaches in least column 8, lines 57-60 wherein "in one embodiment of the present invention, the mechanism for effecting the customer's payment is included in the email message, for example code which creates a "pay the bill" type button," which implies prior user intervention.

The Office has thus given consideration to the remarks and amendments made to the pending set of claims, but are now considered moot in light of the grounds of rejection, provided below, for the current listing of claims.

Claim Rejections – 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **1-20** are rejected under 35 U.S.C. 102(b) as being anticipated by Ensel et al., U.S. Patent 6,493,685.

As per claim **1** (currently amended), Ensel teaches *a method for providing automatic recurring online payments, the method comprising the steps of:*

- *receiving, from a user, an automatic recurring online payment configuration that includes an amount and interval for executing a plurality of automatic recurring payments* [see at least column 10, lines 21-49 and column 12, lines 43-47];
- *determining that one of the automatic recurring payments is to be executed based on the automatic recurring online payment configuration* [see at least column 10, lines 21-49];

- *in response to determining that one of the automatic recurring payment is to be executed, sending a notification to the user to notify the user that one automatic recurring payment is to be executed, the notification being sent to the user before the one automatic recurring payment is executed* [see at least column 10, lines 36-39];

- *determining whether or not to execute the one automatic recurring payment based on at least one of a response to the notification received from the user and a lack of a response to the notification from the user within a specified period of time* [see at least column 7, lines 61-64; column 12, lines 54-67; column 14, lines 57-59].

As per claim **2** (currently amended), Ensel teaches the method of claim 1 as described above. Ensel further teaches the limitation *wherein the automatic recurring online payment configuration further includes a source account for the automatic recurring payments, a recipient of the automatic recurring payments, and at least one payment date* [see at least column 11, lines 54-60].

As per claim **3** (original), Ensel teaches the method of claim 1 as described above. Ensel further teaches the limitation *wherein the notification comprises at least one of an email message and an instant message* [see at least column 14, lines 30-34].

As per claim **4** (currently amended), Ensel teaches the method of claim 1 as described above. Ensel further teaches the limitation *wherein the determining step of determining whether or not to execute the one automatic recurring payment comprises the sub-steps of: receiving the response to the notification from the user; and if the response from the user authorizes the one automatic recurring payment, executing the one automatic recurring payment according to the automatic recurring online payment configuration* [see at least column 8, lines 60-66; column 7, lines 61-64].

As per claim **5** (currently amended), Ensel teaches the method of claim 4 as described above. Ensel further teaches the limitation *wherein the step of determining whether or not to execute the one automatic recurring payment further comprises the sub-step of: if the response from the user modifies*

the one automatic recurring payment, executing the one automatic recurring payment as modified [see at least column 8, lines 60-66; column 7, lines 61-64].

As per claim **6** (currently amended), Ensel teaches the method of claim 4 as described above. Ensel further teaches the limitation *wherein the step of determining whether or not to execute the one automatic recurring payment further comprises the sub-step of: if the response from the user suspends the automatic recurring payments, suspending two or more of the automatic recurring payments* [see at least column 8, lines 60-66; column 7, lines 61-64].

As per claim **7** (currently amended), Ensel teaches the method of claim 4 as described above. Ensel further teaches the limitation *wherein the step of determining whether or not to execute the one automatic recurring payment further comprises the sub-step of: if the response from the user cancels the one automatic payment, canceling the one automatic recurring payment* [see at least column 8, lines 60-66; column 7, lines 61-64].

As per claim **8** (currently amended), Ensel teaches the method of claim 1 as described above. Ensel further teaches the limitation *wherein in the step of determining whether or not to execute the one automatic recurring payment, if a response to the notification is not received from the user within the specified period of time, it is determined to execute the one automatic payment* [see at least column 7, lines 61-64; column 12, lines 54-67; column 14, lines 54-59].

As per claim **9** (currently amended), Ensel teaches the method of claim 1 as described above. Ensel further teaches the limitation *wherein in the step of determining whether or not to execute the one automatic recurring payment, if a response to the notification is not received from the user within the specified period of time, it is determined to suspend the automatic recurring payments or cancel the one automatic recurring payment* [see at least column 7, lines 61-64; column 12, lines 54-67; column 14, lines 54-59].

As per claim **10** (currently amended), Ensel teaches *a computer readable medium encoded with a program for providing automatic recurring online payments, the program comprising instructions for execution by a processing circuit for performing the steps of:*

- *receiving, from a user, an automatic recurring online payment configuration that includes an amount and an interval for executing a plurality of automatic recurring payments* [see at least column 10, lines 21-49 and column 12, lines 43-47];
- *determining that one of the automatic recurring online payments is to be executed based on the automatic recurring online payment configuration* [see at least column 10, lines 21-49];
- *in response to determining that the one automatic recurring payment is to be executed, sending a notification to the user to notify the user that one automatic recurring payment is to be·executed, the notification being sent to the user before the one automatic recurring payment is executed* [see at least column 10, lines 36-39];
- *determining whether or not to execute the one automatic recurring payment based on at least one of a response to the notification received from the user and a lack of a response to the notification from the user within a specified period of time* [see at least column 7, lines 61-64; column 12, lines 54-67; column 14, lines 57-59].

As per claim **11** (currently amended), Ensel teaches the computer readable medium of claim 10 as described above. Ensel further teaches the limitation *wherein the notification comprises at least one of an email message and an instant message* [see at least column 14, lines 30-34].

As per claim **12** (currently amended), Ensel teaches the computer readable medium of claim 10 as described above. Ensel further teaches limitation *wherein the step of determining whether or not to execute the one automatic recurring payment comprises the sub-steps of: receiving the response to the notification from the user; and if the response from the user authorizes the one automatic recurring payment, executing the one automatic recurring payment according to the automatic*

recurring online payment configuration [see at least column 8, lines 60-66; column 7, lines 61-64; column 11, lines 66-67].

As per claim **13** (currently amended), Ensel teaches the computer readable medium of claim 12 as described above. Ensel further teaches the limitation *wherein the step of determining whether or not to execute the one automatic recurring payment further comprises the sub-step of: if the response from the user modifies the one automatic recurring payment, executing the one automatic recurring payment as modified* [see at least column 8, lines 60-66; column 7, lines 61-64].

As per claim **14** (currently amended), Ensel teaches the computer readable medium of claim 12 as described above. Ensel further teaches the limitation *wherein the step of determining whether or not to execute the one automatic recurring payment further comprises the sub-steps of: if the response from the user suspends the automatic recurring payments, suspending two or more of the automatic recurring payments; and, if the response from the user cancels the one automatic recurring payment, canceling the one automatic recurring payment* [see at least column 8, lines 60-66; column 7, lines 61-64].

As per claim **15** (currently amended), Ensel teaches the computer readable medium of claim 10 as described above. Ensel further teaches the limitation *wherein in step of determining whether or not to execute the one automatic recurring payment, if a response to the notification is not received from the user within the specified period of time, it is determined to execute the one automatic recurring payment* [see at least column 7, lines 61-64; column 12, lines 54-67; column 14, lines 54-59].

As per claim **16** (currently amended), Ensel teaches the computer readable medium of claim 10 as described above. Ensel further teaches the limitation *wherein in the step of determining whether or not to execute the one automatic recurring payment, if a response to the notification is not received from the user within the specified period of time, it is determined to suspend the automatic recurring*

payments or cancel the one automatic recurring payment [see at least column 7, lines 61-64; column 12, lines 54-67; column 14, lines 54-59].

As per claim **17** (currently amended), Ensel teaches *a computer system for providing automatic recurring online payments, the computer system comprising:*

- *a receiver receiving, from a user, an automatic recurring online payment configuration that includes an amount and an interval for executing a plurality of automatic recurring payments payments* [see at least column 10, lines 21-49 and column 12, lines 43-47];
- *a processor determining that one of the automatic recurring payments is to be executed based on the automatic recurring online payment configuration* [see at least column 14, lines 54-61];
- *a transmitter sending, in response to determining that the one automatic recurring payment is to be executed, a notification to the user to notify the user that the one automatic recurring payment is to be executed, the notification being sent to the user before the one automatic recurring payment is executed* [see at least column 8, lines 14-15];
- *wherein the [a] processor determines whether or not to execute the one automatic recurring payment based on at least one of a response to the notification received from the user and a lack of a response to the notification from the user within a specified period of time* [see at least column 7, lines 61-64; column 14, lines 57-59];

As per claim **18** (currently amended), Ensel teaches the computer system of claim 17 as described above. Ensel further teaches the limitation *wherein the response to the notification is received from the user, and if the response from the user authorizes the one automatic recurring payment, the processor executes the one automatic recurring payment according to the automatic recurring online payment configuration* [see at least column 8, lines 60-66; column 7, lines 61-64; column 11, lines 66-67].

As per claim **19** (currently amended), Ensel teaches the computer system of claim 18 as described above. Ensel further teaches the limitation *wherein if the response from the user modifies the one automatic recurring payment, the processor executes the one automatic recurring payment as modified* [see at least column 8, lines 60-66; column 7, lines 61-64].

As per claim **20** (currently amended), Ensel teaches the computer system of claim 19 as described above. Ensel further teaches the limitation *wherein if the response from the user suspends the automatic payments, the processor suspends two or more of the recurring payments, and if the response from the user cancels the one automatic recurring payment; the processor cancels the one automatic recurring payment* [see at least column 8, lines 60-66; column 7, lines 61-64].

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date of the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clifford Madamba whose telephone number is 571-270-1239. The examiner can normally be reached on Mon-Thu 7:30-5:00 EST Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi, can be reached at 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Clifford Madamba
Patent Examiner
August 20, 2007

Kambiz Abdi
Supervisory Primary Examiner
August 20, 2007